Appl. No. 10/679,348
Examiner: LEE, EDMUND H, Art Unit 1732
In response to the Office Action dated March 24, 2006

Date: June 24, 2006
Attorney Docket No. 10116631

REMARKS

Responsive to the Office Action mailed on March 24, 2006 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

Present Status of Application

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Atkins (US 5,399,390). Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkins in view of Moshrefzadeh et al (US 6,077,560, hereinafter "Moshrefzadeh") and in further view of Nakahara et al (US 2004/0004691, hereinafter "Nakahara").

In this paper, the specification is corrected to read "R, G, B color filtering layers" in place of "R, G, B photo resists." Claims 1-7 are amended to overcome the rejections under 35 U.S.C. 112 and to correct other informalities. In addition, the claims are corrected to recite "R, G, B color filtering layers" in place of "R, G, B photo resists." Support for the amendments can be found in the original drawings and specification as filed. Claims 8-10 are canceled. Thus, on entry of this amendment, claims 1-7 remain in the application.

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

Rejections Under 35 U.S.C. 112

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this paper, Applicant has amended the claims according to the suggestions of the Examiner and corrected other informalities. Withdrawal of the rejections under 35 U.S.C. 112 is respectfully requested.

Rejections Under 35 U.S.C. 103(a)

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkins in view of Moshrefzadeh and in further view of Nakahara. To the extent that the grounds of the rejections may be applied to the claims now pending in this application, they are respectfully traversed.

The office action fails to establish a *prima facie* case of obviousness in that it does not establish suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings.

MPEP 2142 reads in part:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In connection with the first criteria of the *prima facie* case of obviousness, MPEP 2143.01 states that the prior art must teach the desirability of the claimed invention.

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

Applicant submits that the office action fails to show suggestion or motivation to combine the reference teachings insofar as the desirability of the combination is not taught in the prior art. Furthermore, when the motivation to combine the teachings of the references is not immediately

apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

In this regard, the office action simply states "Atkins, Moshrefzadeh et al, and Nakahara are combinable because they are analogous with respect to liquid crystal displays" and "it would have been obvious to one of ordinary skill in the art at the time the invention was made to jet by inkjet printing a black photo-resist as taught by Moshrefzadeh et al and Nakahara in the process of Atkins to produce a color filter having high quality."

However, the nature of the problem to be solved in each of the cited references is different. There is simply no suggestion in the references themselves or in the knowledge generally available to one of ordinary skill in the art of the ***desirability of the particular modifications*** of Atkins based on Moshrefzadeh and Nakahara proposed by the Examiner in support of his finding of obviousness.

In *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992), the Federal Circuit stated:

> It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600).

It is the Applicant's belief that the present rejection fits the Federal Circuit's description of an impermissible rejection under §103. The Examiner has simply listed certain elements of the present invention and then located isolated disclosures of those components.

Withdrawal of the rejections of claims 1-7 is respectfully requested.

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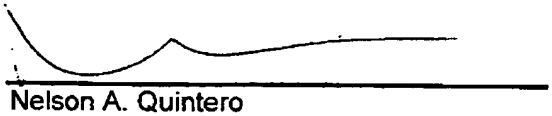
Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so.

Respectfully submitted,



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